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12  
EXAMINER

SIMONE, CATHERINE A

|          |              |
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| ART UNIT | PAPER NUMBER |
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1772

DATE MAILED: 09/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

A 5-12

## Office Action Summary

Application No.

09/883,619

Applicant(s)

WYNALDA ET AL.

Examiner

Catherine Simone

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Withdrawn Rejections***

1. The 35 U.S.C. 112 rejection of claims 1-20 of record in Paper #8, Page 2, Paragraph #2 has been due to the Applicant's argument in Paper #11.

### ***Repeated Rejections***

2. The 35 U.S.C. 102 rejection of claims 1-4, 6, 10, 16 and 17 as anticipated by Roze is repeated for the reasons set forth in Paper #8, Pages 2-3, Paragraph #4.
3. The 35 U.S.C. 103 rejection of claims 5 and 7 over Roze in view of House is repeated for the reasons set forth in Paper #8, Pages 4-6, Paragraphs #6 and #7.
4. The 35 U.S.C. 103 rejection of claim 11 over Roze in view of Udwin et al. is repeated for the reasons set forth in Paper #8, Page 6, Paragraph #8.
5. The 35 U.S.C. 103 rejection of claims 8,9 and 12-15 over Roze in view of Youngs is repeated for the reasons set forth in Paper #8, Pages 6-7, Paragraph #9.
6. The 35 U.S.C. 103 rejection of claim 18 over Roze in view of Gelardi et al. is repeated for the reasons set forth in Paper #8, Pages 7-8, Paragraph #10.
7. The 35 U.S.C. 103 rejection of claim 19 over Roze in view of House and in further view of Gelardi et al. is repeated for the reasons set forth in Paper #8, Pages 8-9, Paragraph #11.
8. The 35 U.S.C. 103 rejection of claim 20 over Roze in view of Youngs is repeated for the reasons set forth in Paper #8, Pages 9-10, Paragraph #12.

*New Rejections*

*Claim Rejections - 35 USC § 102*

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. **Claims 1-6, 10, 16-19, 21 and 22** are rejected under 35 U.S.C. 102(b) as being anticipated by Brinkhurst (GB 2 274 452).

Brinkhurst discloses a storage container for holding items of recorded media, the storage container comprising a cover having a front cover member (Fig. 4, #11), a rear cover member (Fig. 4, #12), and an outer spine (Fig. 4, #8) disposed between the front and rear cover members; the spine having an outer surface and an inner surface, the outer surface of the outer spine being exposed for viewing when the cover is closed; a page having a structure that is adapted to hold at least one item of recorded media (Fig. 4, #13); the page having at least one edge (Fig. 4, #13); the edge of the page (Fig. 4, #13) being connected to the inner surface of the outer spine (Fig. 4, #8) to connect the page to the cover; and the front and rear cover members being moveable between open and closed positions. Regarding **claim 2**, the structure of each page (Fig. 5, #13) is adapted to hold two items of recorded media; the structure holding the items of recorded media on opposite sides of the page (see page 9, lines 10-14). Regarding **claim 3**, each page includes two page halves connected together (Fig. 5, #13). Regarding **claim 4**, each page is substantially rigid (Fig. 5, #13). Regarding **claim 5**, the cover is fabricated from paperboard (see page 5, line 27). Regarding **claim 6**, each page is connected to the cover with an adhesive (see page 9, lines

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20-25). Regarding **claim 10**, the page halves are connected together with adhesive (see page 5, lines 1-2). Regarding **claim 16**, note a further comprising second page having a structure adapted to hold at least one item of recorded media; the second page having at least one edge; the edge of the second page connected to the inner surface of the spine (see page 6, lines 20-25). Regarding **claims 17 and 18**, note the cover defines a hinge between the front cover member and the spine and a hinge between the rear cover member and the spine (see page 9, lines 20-25). Regarding **claims 21 and 22**, note the front and rear covers (Fig. 4, #11 and #12) are free of connections to any pages.

Regarding **claim 19**, Brinkhurst discloses a storage container for holding items of recorded media, the storage container comprising a paperboard cover (see page 5, line 27) having a front cover member (Fig. 4, #11), a rear cover member (Fig. 4, #12), and an outer spine (Fig. 4, #8) disposed between the front and rear cover members; the spine having an outer surface and an inner surface, the outer surface of the outer spine being exposed for viewing when the cover is closed; the cover defining a hinge between the front cover member and the outer spine and a hinge between the rear cover member and the outer spine (see page 6, lines 20-25); each hinge being a living hinge; a page having a structure adapted to hold two items of recorded media on opposite sides of the page (Fig. 4, #13; also see page 6, lines 19-21)); the page having at least one edge (Fig. 4, #13); the edge of the page (Fig. 4, #13) being connected to the inner surface of the outer spine (Fig. 4, #8) with an adhesive to connect the page to the cover (see page 4, lines 26-28 and page 5, lines 1-2); and the front and rear cover members being moveable between open and closed positions.

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11. **Claims 1-6** are rejected under 35 U.S.C. 102(b) as being anticipated by Brinkhurst (GB 2 274 450).

Brinkhurst discloses a storage container for holding items of recorded media, the storage container comprising a cover having a front cover member (Fig. 4, #11), a rear cover member (Fig. 4, #12), and an outer spine (Fig. 4, #8) disposed between the front and rear cover members; the spine having an outer surface and an inner surface, the outer surface of the outer spine being exposed for viewing when the cover is closed; a page having a structure that is adapted to hold at least one item of recorded media (Fig. 4, #13); the page having at least one edge (Fig. 4, #13); the edge of the page (Fig. 4, #13) being connected to the inner surface of the outer spine (Fig. 4, #8) to connect the page to the cover; and the front and rear cover members being moveable between open and closed positions. Regarding **claim 2**, the structure of each page (Fig. 5, #13) is adapted to hold two items of recorded media; the structure holding the items of recorded media on opposite sides of the page (see page 7, lines 15-17). Regarding **claim 3**, each page includes two page halves connected together (Fig. 5, #13). Regarding **claim 4**, each page is substantially rigid (Fig. 5, #13). Regarding **claim 5**, the cover is fabricated from paperboard (see page 5, line 3). Regarding **claim 6**, each page is connected to the cover with an adhesive (see page 4, lines 12-15).

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. **Claim 7** is rejected under 35 U.S.C. 103(a) as being unpatentable over Brinkhurst (GB 2 274 452) or Brinkhurst (GB 2 274 450).

Both Brinkhurst '452 and Brinkhurst '450 disclose a storage container for holding items of recorded media, the storage container comprising a cover having a front cover member (Fig. 4, #11), a rear cover member (Fig. 4, #12), and an outer spine (Fig. 4, #8) disposed between the front and rear cover members; the spine having an outer surface and an inner surface, the outer surface of the outer spine being exposed for viewing when the cover is closed; a page having a structure that is adapted to hold at least one item of recorded media (Fig. 4, #13); the page having at least one edge (Fig. 4, #13); the edge of the page (Fig. 4, #13) being connected to the inner surface of the outer spine (Fig. 4, #8) to connect the page to the cover; and the front and rear cover members being moveable between open and closed positions; each page being adapted to hold two items of recorded media; each page including two page halves connected together; each page being substantially rigid; the cover being fabricated from paperboard. However, both Brinkhurst '452 and Brinkhurst '450 fail to disclose the edge of the page connected to the cover being V-shaped in cross section to provide a pocket for the adhesive.

Normally, it is to be expected that a change in shape of the cross section would be an unpatentable modification. Under some circumstances, however, changes such as shape may impart patentability to a product if the particular shape claimed produces a new and unexpected result which is different in kind and not merely in degree from the results of the prior art. *In re Dailey et al*, 149 USPQ 47 CCPA 1966.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to change the shape of the cross section of the edge of the page

in either Brankhurst '452 or Brankhurst '450 to a V-shape. One skilled in the art would have been motivated to do so in order to form a storage container for holding items of recorded media, since it has been held that the change in form or shape of the cross section would be an unpatentable modification absent of showing unexpected results.

14. **Claims 8, 9 and 12-15** are rejected under 35 U.S.C. 103(a) as being unpatentable over Brinkhurst (GB 2 274 452) or Brinkhurst (GB 2 274 450) in view of Youngs (4,850,731).

Both Brinkhurst '452 and Brinkhurst '450 disclose Brinkhurst discloses a storage container for holding items of recorded media, the storage container comprising a cover having a front cover member (Fig. 4, #11), a rear cover member (Fig. 4, #12), and an outer spine (Fig. 4, #8) disposed between the front and rear cover members; the spine having an outer surface and an inner surface, the outer surface of the outer spine being exposed for viewing when the cover is closed; a page having a structure that is adapted to hold at least one item of recorded media (Fig. 4, #13); the page having at least one edge (Fig. 4, #13); the edge of the page (Fig. 4, #13) being connected to the inner surface of the outer spine (Fig. 4, #8) to connect the page to the cover; and the front and rear cover members being moveable between open and closed positions. However, both fail to disclose the page halves connected with locking fingers and a literature card disposed between the page halves. Youngs teaches that page halves being connected with locking fingers (Fig. 4, #70) and a literature card (Fig. 4, #12) disposed between the page halves is old and well-known in the analogous art for the purpose of producing a storage container for holding recorded media.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided locking fingers to connect the page halves and



a literature card disposed between the page halves in either Brinkhurst '450 or Brinkhurst '452 as suggested by Youngs in order to produce a storage container for holding recorded media.

15. **Claim 11** is rejected under 35 U.S.C. 103(a) as being unpatentable over Brinkhurst (GB 2 274 452) or Brinkhurst (GB 2 274 450) in view of Udwin et al. (6,106,015).

Both Brinkhurst '452 and Brinkhurst '450 disclose Brinkhurst discloses a storage container for holding items of recorded media, the storage container comprising a cover having a front cover member (Fig. 4, #11), a rear cover member (Fig. 4, #12), and an outer spine (Fig. 4, #8) disposed between the front and rear cover members; the spine having an outer surface and an inner surface, the outer surface of the outer spine being exposed for viewing when the cover is closed; a page having a structure that is adapted to hold at least one item of recorded media (Fig. 4, #13); the page having at least one edge (Fig. 4, #13); the edge of the page (Fig. 4, #13) being connected to the inner surface of the outer spine (Fig. 4, #8) to connect the page to the cover; and the front and rear cover members being moveable between open and closed positions. However, both Brinkhurst '452 and Brinkhurst '450 fail to disclose the page halves being connected with a weld. Udwin et al. teaches it is old and well-known in the analogous art to have welding (see col. 6, lines 10-12) for the purpose of providing secure attachment of each page halve in producing a storage container for recorded media.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided a weld in either Brinkhurst '450 or Brinkhurst '452 as suggested by Udwin et al. in order to provide a secure attachment of each page halve to produce a storage container for recorded media.

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16. **Claims 20 and 23** are rejected under 35 U.S.C. 103(a) as being unpatentable over Brinkhurst (GB 2 274 452) or Brinkhurst (GB 2 274 450) in view of Youngs.

Both Brinkhurst '450 and Brinkhurst '452 disclose a storage container for holding items of recorded media; the storage container comprising a cover having a front cover member (Fig. 4, #11), a rear cover member (Fig. 4, #12), and an outer spine (Fig. 4, #8) disposed between the front and rear cover members; the spine having an outer surface and an inner surface, the outer surface of the outer spine being exposed for viewing when the cover is closed; a page having a structure (Fig. 4 and 5, #13) adapted to hold two items of recorded media on opposite sides of the page; the page (Fig. 4, #13) having at least one edge; the edge of the page being connected to the inner surface of the outer spine (Fig. 4, #8) with an adhesive to connect the page to the cover; each page (Fig. 4, #13) being substantially rigid and including two halves; and the front (Fig. 4, #11) and rear (Fig. 4, #12) cover members being moveable between open and closed positions. However, both Brinkhurst '452 and Brinkhurst '450 fail to disclose a literature card being disposed between the page halves. Youngs teaches it is old and well-known in the analogous art to have a literature card (Fig. 4, #12) being disposed between page halves for the purpose of producing a storage container for holding items of recorded media.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided a literature card being disposed between the page halves in either Brinkhurst '450 or Brinkhurst '452 as suggested by Youngs in order to produce a storage container for holding items of recorded media.

Regarding **claim 23**, note in Brinkhurst '450 and Brinkhurst '452 the front and rear covers are free of connections to any pages (Fig. 4, #11 and #12).

*Response to Arguments*

17. Applicant's arguments filed July 10, 2003 have been fully considered but they are not persuasive. Regarding claims 1-4, 6, 10 16 and 17, Applicant states that "The Applicant submits that these amendments clearly distinguish the Roze reference wherein the disc-holding pages are connected to element 60 which is described as a flexible securing member (column 3, lines 26-27) that is connected to the inner surface of the front and rear covers. The Roze reference thus specifically discloses and teaches that the disc-holding pages are spaced from the inner surface of the outer spine. The amended claims recite a different structure." However, the Roze reference clearly teaches "an outer spine (Fig. 2, between element 52 and element 51) disposed between the front and rear cover members (Fig. 2, element 40 and element 20); the spine having an outer surface and an inner surface, the outer surface of the outer spine being exposed for viewing when the cover is closed; and the edge of the page (Fig. 2, element 30) being connected to the inner surface (Fig. 2, element 60) of the outer spine to connect the page to the cover" as recited in the newly amended claims. In regards to element 60, it is described as a flexible securing member (column 3, lines 26-27), however, it is the inner surface of the spine to which the page is connected (shown in Figure 2).

Regarding claim 7, Applicant states "The Examiner has not, however, cited any disclosure in either reference for disclosing, teaching, or suggesting the V-shaped page edges as specifically cited in independent claim 7. The Examiner contends that the V-shaped cross-section is merely an unpatentable change in cross-section. The Applicant respectfully submits that the addition of the V-shaped page edges provides a significant benefit that was not recognized in the art because the pages of the invention may be directly secured to the inner surface of the outer

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spine with an adhesive as described in Applicant's specification and shown in Applicant's drawings. References such as Roze use flat page ends that do not leave room for pockets of adhesive to secure the page edges." However, Roze does teach flat page ends and it would be a change in shape to have the page ends be V-shaped in cross section and a change in shape is an unpatentable modification absence of showing unexpected results.

Regarding claim 19, Applicant states "Independent claim 19 has been amended to specifically recite that the page having the structure to hold two items of recorded media on opposite sides of the page is connected to the inner surface of the outer spine. The references cited by the Examiner fail to disclose, teach or suggest this structure. The addition of the House and Gelardi references to the Roze reference does not add the required disclosure. The Examiner cites Gelardi as providing the teaching for a living hinge. The Applicant notes that the Gelardi living hinge is not disposed in the cover but is disposed in the page." However, it is to be pointed out that Roze clearly teaches a page having a structure adapted to hold two items of recorded media on opposite sides of the page (Fig. 2, #30; also see col. 3, lines 13-17) and the edge of the page being connected to the inner surface (Fig. 2, #60) of the outer spine. The House reference was merely cited to teach that it is old and well-known in the art to have a cover being made of paperboard and it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the cover in Roze be made of paperboard as suggested by House in order to produce a storage container for holding items of recorded media. Furthermore, the Gelardi reference was merely cited to teach that it is old and well-known in the art to have a living hinge and it would have been obvious to one of ordinary skill in the art at the time the

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invention was made to have a living hinge in Roze as suggested by Gelardi in order to produce a storage container for holding items of recorded media.

Regarding claim 20, Applicant states "The Applicant again submits that the Roze reference fails to disclose, teach, or suggest the page and spine arrangement now recited in amended claim 20. Independent claim 20 also specifically recites that a literature card is disposed between the page halves. The Examiner cites Youngs' as disclosing this feature. The Youngs' reference does not have substantially rigid pages that are formed from two halves with the literature card disposed between the halves as specifically recited in claim 20. The Youngs' reference discloses a flexible pocket wherein a literature card may be slipped between two flexible substrates." However, Roze again clearly teaches "an outer spine (Fig. 2, between element 52 and element 51) disposed between the front and rear cover members (Fig. 2, element 40 and element 20); the spine having an outer surface and an inner surface, the outer surface of the outer spine being exposed for viewing when the cover is closed; and the edge of the page (Fig. 2, element 30) being connected to the inner surface (Fig. 2, element 60) of the outer spine to connect the page to the cover." The Youngs reference was merely cited to teach that it is old and well-known in the art to have a literature card disposed between page halves and it would have been obvious to one of ordinary skill in the art at the time the invention was made to have a literature card disposed between the two page halves in Roze as suggested by Youngs in order to produce a storage container for holding items of recorded media.

*Conclusion*


18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Catherine Simone whose telephone number is (703)605-4297. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on (703) 308-4251. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

  
Catherine Simone  
Examiner  
Art Unit 1772  
September 16, 2003

  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
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9/17/03